REMARKS

The Office Action dated July 14, 2006, has been received and carefully considered. In this response, claims 1-3, 5-8, 11, 12, 14, 19, and 20 have been amended. Entry of the amendments to claims 1-3, 5-8, 11, 12, 14, 19, and 20 is respectfully requested. Reconsideration of the outstanding rejections in the present application is also respectfully requested based on the following remarks.

I. THE NON-STATUTORY SUBJECT MATTER REJECTION OF CLAIMS 14-20

On page 2 of the Office Action, claims 14-20 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. This rejection is hereby respectfully traversed.

The Examiner asserts that, in contrast to what is recited in the preamble, claims 14-20 do not actually accomplish the storing of data. Applicants respectfully disagree. However, for purposes of forwarding the present application toward allowance, Applicants have amended claims 14-20 to be directed toward a method for controlling data storage.

In view of the foregoing, it is respectfully requested that the aforementioned non-statutory subject matter rejection of claims 14-20 be withdrawn.

II. THE INDEFINITENESS REJECTION OF CLAIMS 1-20

On pages 2-3 of the Office Action, claims 1-20 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention. This rejection is hereby respectfully traversed.

Regarding claims 1-20, the Examiner asserts that the usage of the term "high speed" is indefinite. Applicants respectfully disagree. However, for purposes of forwarding the present application toward allowance, Applicants have amended claims 1-20 to remove the term "high speed" as being unnecessary for patentability.

Regarding claim 14, the Examiner asserts that the usage of the term "permit" is indefinite. Applicants respectfully disagree. However, for purposes of forwarding the present application toward allowance, Applicants have amended claims 14 and 19 to remove the term "permitting."

In view of the foregoing, it is respectfully requested that the aforementioned indefiniteness rejection of claims 1-20 be withdrawn.

III. THE OBVIOUSNESS REJECTION OF CLAIMS 1-20

On pages 3-7 of the Office Action, claims 1-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Strasser (U.S. Patent No. 6,990,603) in view of Taylor et al. (U.S. Patent No. 6,263,398). This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a prima facie case of obviousness. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Patent Office can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of references. Id.. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). That is, under 35 U.S.C. § 103, teachings of references can be combined only if there is some suggestion or motivation to do so. Id.. However, the motivation cannot come from the applicant's invention itself. In re Oetiker, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992). Rather, there must be some reason, suggestion, or

motivation found in the prior art whereby a person of ordinary skill in the art would make the combination. Id..

Regarding claim 1, the Examiner asserts that Strasser teaches a non-volatile electronic memory configuration comprising: a volatile memory; a non-volatile memory coupled to the volatile memory; a controller coupled to the volatile memory and the non-volatile memory that controls the transfer of stored data from the volatile memory to the non-volatile memory, and vice-versa, when power is above a particular minimum operating voltage level; and a power level detector that detects when power is above the particular minimum operating voltage level. The Examiner acknowledges that Strasser fails to teach a controller coupled to a volatile memory and a non-volatile memory that monitors data storage changes made within the volatile memory. However, the Examiner asserts that Taylor et al. teaches a memory system employing a non-volatile memory coupled to a cache for performing a write through technique, and thus it would have been obvious to combine the teachings of Strasser and Taylor et al. to arrive at the claimed invention.

Applicants respectfully disagree. Specifically, Applicants respectfully submit that Strasser and Taylor et al., either alone or in combination, fail to teach, or even suggest, a controller coupled to a volatile memory and a non-volatile

memory that monitors data storage changes made within the volatile memory, as claimed. The Examiner refers to column 8, lines 16-18, and column 8, line 59, to column 9, line 16, of Taylor et al. for teaching this claim limitation. However, Taylor et al. merely teaches that data is written simultaneously to a cache and a non-volatile memory. Such a teaching does not even imply that data storage changes made within the volatile memory are monitored for later use in transferring data stored in the volatile memory to the non-volatile memory based upon those monitored data storage changes. Indeed, such a teaching even teaches away from the claimed invention by eliminating the claimed feature of transferring data stored in the volatile memory to the non-volatile memory based upon those monitored data storage changes. At this point, Applicants would like to remind the Examiner that, as stated in MPEP § 2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). That is, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). Since the cited references clearly do not teach, or even suggest, all of

the claimed limitations, *prima facie* obviousness of a claimed invention has not been established.

In view of the foregoing, it is respectfully submitted that Strasser and Taylor et al., either alone or in combination, fail to disclose, or even suggest, the claimed invention. Accordingly, it is respectfully submitted that claim 1 should be allowable.

Regarding claims 2-13, these claims are dependent upon independent claim 1. Thus, since independent claim 1 should be allowable as discussed above, claims 2-13 should also be allowable at least by virtue of their dependency on independent claim 1. Moreover, these claims recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination. For example, claims 6 and 7 recite that the volatile memory is a dual port, dynamic random access memory coupled to both the non-volatile memory and the controller in a particular configuration. However, nowhere do Strasser and Taylor et al. disclose, or even suggest, such a feature. Indeed, the Examiner even fails to mention how Strasser and Taylor et al. disclose, or even suggest, such a feature.

Regarding claims 14-20, these claims recite subject matter related to claims 1-13. Thus, the arguments set forth above

with respect to claims 1-13 are equally applicable to claims 14-20. Accordingly, is it respectfully submitted that claims 14-20 are allowable over Strasser and Taylor et al. for the same reasons as set forth above with respect to claims 1-13.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 1-20 be withdrawn.

IV. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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